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Serial Number: 10/724,653

Application Filed: 2003 December 1

Applicant: Lyons, Michael L.

Application Title: Front Pocket Wallet Used to Prevent Spinal Misalignment

Examiner/GAU: Tri M. Mai/3727

Mailed: 2007 August 30

At: Gorham, Maine

REPLY BRIEF TO EXAMINER'S ANSWER

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir,

Responsive to the Examiner's Answer mailed 2007 July 13, Applicant herewith submits his Reply Brief. Included with the Reply Brief is an Information Disclosure Statement.

Very respectfully,

Nils Peter Mickelson

Registration Nr. 40,089

207-929-4840

Certificate of Mailing

I certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with proper postage affixed in an envelope on the date indicated below and addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450."

Signed: _____

Nils Peter Mickelson
Registration Nr. 40,089

30 AUG 07

Date



REPLY BRIEF

in

**APPLICATION SER. NR. 10/724,653
FILED 2003 December 1**

to Examiner's Answer mailed 2007 July 13

REAL PARTY IN INTEREST

The real and sole party in interest in this Appeal is the Applicant, Michael L. Lyons.

RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claims 1-11 and 13-22 are cancelled.

Claim 12 is rejected.

Objection has been raised to Claims 14 - 22 as being dependent upon a rejected base claim (Claim 13). In his Final Action, mailed 2006 June 6, the Examiner has stated that these claims would be allowable if rewritten into independent form, which they have so been in Amendment B after Final Action.

Pursuant to Amendment B, responsive to Final Action, and mailed 2006 September 5, these claims rewritten as Claims 26-34 are now in allowable form.

Claim 12 is being appealed herewith.

Regarding the Rejection of Claim 12 under 35 U.S.C. §112, second paragraph

The Applicant sincerely thanks the Examiner for releasing the rejection of Claim 12 under 35 U.S.C. §112, second paragraph, and hopes herewith to overcome the two standing rejections thereto as well.

Regarding Examiner's Answer 3 — Status of Claims

The Application as filed 2003 December 1 entered Claims 1-11. The first Office Action mailed 2005 November 16 admitted Claims 1-11 as pending, objected to Claim 10 and rejected Claims 1-9 and 11.

In Amendment A to the above Application, mailed 2006 February 16, Applicant amended the Title and canceled and re-wrote Claims 1-11 as new Claims 12-22, in particular to overcome rejections raised by the Examiner in light of a wristband by Giard (U.S. 5,671,481).

The second — and final — Office Action mailed 2006 June 6 admitted new Claims 12-22 as pending, rejected new Claims 12 and 13 on new grounds, in particular a portfolio by Wieland (U.S. 6,019,922), and raised objection to new Claims 14-22 "as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims."

In a telephonic Interview after Final Action, granted on 2006 August 17, the outstanding issues were extensively discussed. The Examiner stated and reiterated that there were already some allowed claims, affirming the allowability of Claims 14-22 stated in his Final Office Action, if rewritten as independent.

Subsequently, after-final Amendment B was drafted and mailed 2006 September 5, so re-writing Claims 14-22 in independent form as new Claims 26-34 which rendered them allowable as affirmed in Advisory Action mailed 2006 November 2. Amendment B furthermore canceled rejected Claim 13, leaving only Claim 12 under consideration. Amendment B amended Claim 12 as well, to meet the Examiner's new rejection raised in the Final Office Action (and as also discussed in the above Interview) and added new dependent Claims 23-25 to Claim 12 as suggested by the Examiner in the Interview.

Amendment B was not entered.

Thus Applicant has amended his Application twice — first to cancel Claims 1-11, substituting new Claims 12-22, and again to cancel Claim 13, to cancel and rewrite its dependent Claims 14-22 in independent form as new Claims 26-34 as required by the Examiner, to present Claim 12 in better form for appeal in the light of the newly-raised Wieland reference, and at the Examiner's suggestion to add new dependent Claims 23-25 thereto.

The Appeal is from the Examiner's Final Action. The Examiner's refusal to admit Amendment B does not in any way operate to relieve the Application, as amended by its owner, from its condition as being subject to appeal.

Applicant's status of claims stands correct as written. Claim 12 (unamended) is the only claim remaining under consideration, currently standing rejected under 35 U.S.C. 112, first paragraph, and 35 U.S.C. §102(b).

Regarding Examiner's Answer 8 — Evidence Relied Upon

Materials submitted in the Evidence Appendix to the Appeal Brief have been supplied in an effort to ensure that the Board have before them the same — or as nearly the same — as that previously supplied the Examiner with Amendment A on 2006 February 16. In the intervening time, the Applicant's new field has grown, and similar but more current material has been published which was thus made available in the Appendix as well.

Section 1205.02 (Appeal Brief Content) of the MPEP as currently publicly posted reads "If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief." The Applicant has done precisely that.

The Notice of Non-Compliant Appeal Brief mailed 2007 March 14 which is cited in the Examiner's Answer mentions simply that evidence in the Appendix has not been considered. The matter of supplying an IDS form was not raised, and thus was not addressed in the Appeal Brief. Thus, the Examiner's statement that "the Examiner raises this issue in the Notice of Non-Compliant Appeal Brief dated 05/14/2007" is incorrect.

An IDS form is included herewith, which the Applicant hopes meets this objection.

Applicant notes that Section 1205.02(ix) of the MPEP as currently publicly posted states that an Evidence Appendix is "An appendix containing copies of any evidence submitted pursuant to 37 CFR 1.132 or any other evidence entered by the examiner and relied upon by the appellant in the appeal, along with a statement setting forth where in the record that evidence was entered . . . Reference to unentered evidence is not permitted in the brief." All evidence submitted in the Appeal Brief, expected by MPEP 1205.02 as cited above, is fully supported by the evidence submitted under 37 CFR §1.132 in Amendment A mailed 2002 February 16.

Regarding Examiner's Answer 9 — Grounds of Rejection under 35 U.S.C. §112, first paragraph

The Applicant's invention was conceived from the outset as being a normal pocket wallet, improved by the Applicant's inventive measure of providing one of its edges with tapering so that it ideally fits for use in a gentleman's front trousers pocket.

The Applicant first described his invention in Preliminary Patent Application 60/430209 filed 2002 December 2.

At that time, and prior to that time, the Applicant's invention and even his first model thereof was characterized — as are normal pocket wallets — by having a single fold line where the wallet has been folded for use in the pocket. All of the Applicant's applications and amendments have explicitly supported, both verbally and graphically, this construction. The single fold line appeared in the original drawings of 2002 December 2, as well as in subsequent Fig. 1 of the formal Application of 2003 December 1, where it appears identified as item number 11, Fold Line.

In the Provisional and in the Regular Application, Fig. 1 and Fig. 2 fully support the Detailed Description in clearly showing one, single and no other, fold or fold line. The wallet is either folded — once — or unfolded. The Specification makes clear the background of the art as generally rectangular in shape, matching the shape of folding currency and the shape of a rear pocket. It further makes clear that the invention is just such a wallet which, when folded, has a tapered end shaped to fit a front pocket.

The Detailed Description in the Provisional Application reads:

"Referring to Figure 1, what is seen is the appearance of the wallet in its normal, closed configuration. Obvious is the rounded tapering of the wallet's width, such that it approximates the shape of a typical trousers front pocket." (sic)

"Figure 2 shows the wallet unfolded in its open configuration, . . . "

"Figure 3 shows the empty wallet in its preferred embodiment, and further reveals lines along which sequential layers of material are bonded together, . . . "

From the outset, the Applicant has acknowledged multiple layers, and that they are engaged in the folding process at the single fold line, while he has also taught that his wallet (not the number of its layers) is folded once at a single place — the fold line.

There is one fold line in the invention. There is one fold line shown and discussed in all the applications. Claim 12 was amended in Amendment B (after final) to clarify misunderstanding or misinterpretation regarding this single fold line by declaring Claim 12 to having a single fold line — at no time introducing new material or restrictions to the invention as originally conceived and as originally claimed.

When one is claiming a structure that is adapted to assume more than one normal configuration, it is essential to the written description not only to disclose the mechanism by which it is so enabled, but also to state in which configuration it stands during such description and claim. A hinge, for example, has a hinge axis about which it hinges, and two pointed ends when open — yet only one when closed.

Regardless how many layers may be folded within this single fold at the single fold line, there remains a single fold line about which the wallet is once and only once folded. That each such layer may thus also be folded (or not, as in Card Pocket 38 or Transparent Panel 35) is not relevant to the written description of the folded wallet itself.

Semantics

In a written description, the language of writing, and the meaning of its words and its symbols and its structure play a critical role. In patent claims, this may well be more so than in any other field of writing. In this case — and a large part of the reason for appeal — there is a persistent conflict in the use and understanding of words which the Applicant prays may be resolved.

Fold

The word "fold" can be seen in two ways: as a noun or name ("a single fold") and as a verb or action ("to fold at a place"). Its origins derive from the protection of cherished possessions — "gathering the sheep safely into the fold" or "enfolding your children in your arms." The verb (action) form particularly derives from this action of swinging closed as with a gate or an arm, or in this case a wallet. To lay one part (of the wallet) over another part (of the wallet). To reduce the length of (the wallet) by doubling over. To clasp together, as in "folded hands."

In its nominative (noun) form, "fold" refers to "a margin apparently formed by doubling upon itself of a membrane or other flat structure." In this case, that 'flat structure' is the wallet, and "the fold" is the outermost outline of the folded wallet, at the end where the fold line is.

Crease

The word "crease" derives from early forms of "crest" — the top of a hill or mountain. The crease is a line or mark made by, or as if by, folding a pliable substance. When an item is folded, the action of folding makes a crease. When five layers of a layered item are folded, the action of folding (once)

makes simultaneously five creases. Even if unfolded, depending upon the nature of the material, there can remain these five creases as a permanent deformation of the material, as in trouser creases.

Single

The word "single" derives from the Latin "singulus" or "one only." Its English definition is "alone; solitary; consisting of or having only one part, feature or portion; consisting of only one in number."

A

The word "a" derives from (and is still in use as) the word "an" (the modern Swedish word *en* means both "one" and "an" in English). It denotes a single item, as in "a car." It never suggests or implies more than one.

Line

The word "line" derives from the Latin name *linea* for a plant that we today call "flax" — a slender, erect annual plant, in its earliest form used to weave mats, but today "linen." A line is a narrow real or imaginary boundary oriented in terms of stable points of reference; a boundary division or contour; a defining outline; a straight geometric element.

Applicant's line is just that, as with a property line: "a place where" the wallet folds. It is not a crease, formed in a layer or in any number of layers by the action of folding the wallet.

Regarding Examiner's Answer 9 — Grounds of Rejection under 35 U.S.C. §102(b) over Wieland

To say "the wallet has a single fold line" is to uniquely and properly describe the invention as it was conceived, as it has been shown, and as it is claimed. Anyone skilled in the art of designing or constructing wallets would, first of all, presume a single fold line unless told otherwise, and secondly understand that any reference to "a fold line" would refer to a singular fold line — to one single fold line. To extract "multiple fold lines" from the Applicant's disclosure is far beyond reaching.

Examiner's Interpretation 1

It is clear from Wieland Fig. 1 that his pocket book has not a single fold line but in fact at least two fold lines. Wieland's first fold line extends across the bottom end of his device — from approximately his letter "f" to his letter "e" in the Examiner's illustration. In Wieland's own words, "In Figs. 1 and 2 the paper is folded twice, thereby producing four thicknesses . . . two outer pockets c c and an intermediate . . . space d." To apply "thicknesses" consistently as descriptive language, where Wieland's two folds produce four "thicknesses," Applicant's single fold produces four such thicknesses, when only the basic layers of Outer Panel 14 and Inner Panel 15 are considered, six such thicknesses with Separator Panel 34 included, and an arbitrarily larger number of thicknesses as further features are added to his wallet.

Applicant's wallet comprises a single fold (at Fold Line 11), and stitched or bonded outer ends rather than Wieland's "two outer pockets . . . open at the front and at one end." Again, it should be noted that Wieland properly refers here to an "end" when he refers to his top — and not to an "edge."

Whereas a square object is geometrically defined by four equal edges, a rectangle lacks this symmetry and has edges of unequal length. Its longer edges remain "edges" (note that Wieland's words "and of folding . . . lengthwise as shown in the drawings" define his "length" and thereby his longer edges). The rectangle's shorter edges are "ends" (Wieland's top and bottom ("open at both ends . . . permitting long documents to be projected equally from each end")). The Examiner misconstrues these edges in his interpretation and renames "edge" and "end" oppositely from convention.

The fact is that Wieland describes his invention while it is standing with its longer edges vertically, the nearest edge at the "front," while Applicant describes his invention as it is resting with its longer edges horizontally. Wieland sees his invention as "open at the front and at one (top) end" (what the Examiner calls "edge") at pockets "c" and "c." Applicant's wallet is open along one edge only, and bonded or stitched closed at its ends — like a wallet.

Examiner's Interpretation 2

In this interpretation, the Examiner elects to properly identify edges and ends, but again misses the clarity of claiming a "single" fold line. Wieland plainly has more than a single fold line: "In Figs. 1 and 2 the paper is folded twice, therefore producing four thicknesses." Applicant's wallet is in no way folded twice. As in the Applicant's invention, the details of Wieland are significant and must be properly considered. Were the two inventions not in such disparate fields, one could almost argue that the Applicant has improved by omission.

Examiner's Interpretation 3

In his third interpretation, the Examiner notes two pockets — each comprised of "portion a" and "portion b." Notwithstanding the fact that the edges of Wieland's two pockets extend completely around the corner onto two adjacent sides of the rectangle ("the front and one end") while the Applicant's pocket extends only along the one (shorter of the two) edge, the Examiner's reconstruction would entail three — rather than two — fold lines. The Applicant has but a single one.

Wieland's pocket book (a book with pockets) — today a portfolio or page protector — was conceived not to be worn on a daily basis (as a wallet) for centralizing the many cards, tokens, bills, magnetic strips, personal devices and so forth that men carry with them today, but instead to protect special papers ("a pocket book suitable for carrying bank-bills and documents"), in much the same manner as an envelope. The era of invention and the intended use are vastly different. Wieland's pocket book is especially

viewed as "an advertising medium" to "involve a minimum cost of manufacture." The sort of disposable ("gratuitous") portfolio or folder that a commercial bank today might use to present one their mortgage papers. All of Wieland is directed to protecting his product — not the user — "to make the book (note the word "book") more durable." Wieland's invention is used today with what we now call manila file folders, "an inner and outer sheet connected with each other at one edge only," with their simple rounded corners so they don't become prematurely bashed by normal use. As with such a file folder, Wieland is open for "permitting long documents to be projected equally from each end," where the Applicant's invention is closed.

At no point does Wieland mention or even suggest that his invention would be inserted into a garment pocket, let alone see daily wallet-like use. Wieland's book with pockets, formed of stiff paper, is structurally incapable of performing the function of a wallet for regular use in a front trousers pocket. Not only would Wieland suffer irreparable damage the moment its user assumed a seated position, but equally important any long documents "projected equally from each end" would be crushed when his "rounded" corner was inserted first into such a trousers pocket.

Intended Use

The Applicant has made clear throughout prosecution that his invention's "intended use" is as "a wallet shaped to fit" — and thus implicitly and consistently described as being used in — "a front trousers pocket." The Examiner states — incorrectly — that "obviates spinal misalignment" is an intended use. It is not.

Obviating spinal misalignment is a positive health benefit derived from the invention's unique shape and from its new intended use in a front trousers pocket. It does not appear in the preamble to Claim 12, but rather in a "whereby" clause emphasizing the unique benefit of the Applicant's invention.

The recitation of the Applicant's intended use in a front trousers pocket obviously (in the Examiner's words) "results in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art" — noting that the Examiner, not the Applicant, considers Wieland to be analogous prior art.

Even the Applicant's original Claim 1 patentably distinguished, but was rejected solely on the subjective evaluation that it was "too broad." A breakthrough is always entitled to its breadth.

Adding the restrictions of Claim 12 during the prosecution to original Claim 1 serves to tie the preamble more directly to the claim. (see *Metabolite Labs., Inc. v. Corp. of Am Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004)) — "a preamble may provide context for claim construction,

particularly where . . . that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history" as it does here.

Even if Wieland is taken as relevant prior art, which it is not, then all the manifest differences between the structures of Wieland and of the Applicant definitely distinguish. Moreover, the use of Wieland for Applicant's intended use would be wholly unrealistic. A pocket handkerchief would be more capable of the Applicant's intended use than Wieland's stiff paper portfolio.

Regarding Examiner's Answer 10 — Response to Argument ("112, 1st rejection")

Both the Applicant and the Examiner have extensively discussed the interpretation of folds, fold lines, creases, etc. The Examiner's Answer here is, at best, oblique and confusing to the Applicant. He cannot properly respond to the Examiner's Answer — as written — without further clarification, but asserts once again that the amendment after Final Action (Claim 12 amended) inserts no "new" recitation or restrictions unsupported in the history and Specification, and that such amendment was made for — and did effect — placing amended Claim 12 in full condition for allowance.

Regarding Examiner's Answer 10 — Response to Argument ("102 rejections")

The Applicant is aware of only one such rejection, and requests clarification if the Examiner knows of others. Applicant also notes that the Examiner's use of the words "the single fold lines" further and unnecessarily confuses the discussion. Applicant has always seen only one, solitary, singular, single fold line in his invention; the use of the plural form here implies otherwise, and is incorrect.

Because Claim 12 (and original Claim 1) has always been restricted to a wallet, Applicant would perforce be required to stipulate if there were more than one fold line as a part of his invention, as for example, in a "bi-fold" wallet. Claim 12 simply moves this construction from the specification into an otherwise unnecessary restriction in the claim. There is no supportable evidence whatever that makes the Applicant's novel construction obvious or anticipated.

Regarding Examiner's Answer — Product by Process Claim

Nowhere is this matter more clear than in the rejections citing Wieland — and earlier Giard — based on the shape of the invention. The tapering along one edge is wholly unique and unanticipated, completely unlike the nominally-rounded, typically die-cut corners of conventional wallets, Wieland's paper book, and the ends of the Applicant's own Longer Edge 16. It is not that "the prior product was made by a different process," but that the structure in the Applicant's invention is entirely novel. Indeed the unique and substantial tapering along one edge to fit a front trousers pocket is the very crux of the Applicant's invention.

It is, in fact, this novel structure — in a wallet — that the Applicant claims. It is not the process by which it is made, and thus it cannot be a "product-by-process" claim. What the Applicant consistently defines is the structural difference between a substantially rounded tapering along a specific edge and a generically-rounded (but essentially sharp) corner that has historically been used in a vast array of different products. There is no functional structural similarity between the invention and Wieland.

Regarding Examiner's Answer — Reading Limitations

All of the Applicant's invention is drawn to the tapering at the end of edge 13. At every turn it is described, again and again, as distinguished from contemporary wallets of generally rectangular shape, by having a tapered end, by having Rounded Tapering 12, by having unilaterally rounded tapering, such that it approximates the shape of a typical trousers front pocket (examples provided), as a trapezoid with convexly-rounded diagonal legs . . .

By raising Wieland in his Final Office Action, the Examiner has terminally forced the Applicant to draw such well-supported but otherwise unnecessary language into the claim, to properly and forcefully distinguish over Wieland's paper pocket book. Applicant could as well draw in the Examiner's suggested restriction to "stitched at the end," were it to overcome the rejection. All are supported in the Specification and the drawings.

Summary

The Applicant has at all times asserted that his invention is a wallet shaped to fit a front trousers pocket; it is neither a wristband nor a portfolio for protecting important papers. The Examiner has drawn references from fields with no relevance to the Applicant's inventive act — faced with the problem of restructuring a wallet to encourage and facilitate its use in a front trousers pocket such that it fits the wearer's anatomy in a manner that is both comfortable and simultaneously ameliorates spinal misalignment and the attendant chronic results thereof.

No one working in the field of pocket wallets would look — or be encouraged to look — into the field of athletic sweat bands to wear around a wrist or the field of document protectors adapted as advertising media. The relation between these fields is distant at best, and would at the least require a cogent argument supporting their adaptation within the Applicant's invention. No such exists. Indeed, at no point does Wieland teach or imply that his book with pockets should ever be used in, or even inserted in, a person's pocket — or even to carry folding currency.

Even if the Examiner's holding that Wieland is analogous prior art were held correct, which it is not, surely the new and unanticipated results of the Applicant's wallet — were it to include any of Wieland's old and distant construction — would themselves warrant a patentable invention.

It should be clear that Wieland is not a relevant reference — not even analogous prior art. Wieland's "pocket-book" is — as with a ladies' pocketbook — to be carried, but not in a pocket. At every occasion, Wieland makes clear that his invention teaches a gratuitous book with pockets, made of inexpensive stiff paper to protect and carry bank bills or documents and to be used for bearing printed advertisements. Wieland's invention lies in the field of stationery and not in the high-end field of fine leather wallets for use in trousers pockets. His teachings are in no way pertinent to the particular problem faced by the Applicant of adapting a conventional trousers wallet in a new and unique way to fit and be used within a front trousers pocket.

The Applicant's amended Claim 12 is properly drafted to overcome each and every rejection in light of Wieland and should have certainly been allowed as patentable and as fully responsive to the Final Office Action. It raises no new issues for consideration whatsoever.